

03-07-07

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ralph S. Norman  
Serial No.: 10/801,626  
Filed: 03/15/2004  
For: Improved Fluidic Dampening Device  
Confirmation No.: 2931  
Group Art Unit: 3683  
Examiner: Robert A. Siconolfi  
Customer No.: 31198  
Attorney Docket No.: PNORMI

Mail Stop Appeal Brief-Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

EXPRESS MAIL CERTIFICATE

Express Mail Label No. ER632009271US

Date of Deposit: March 5, 2007

I hereby certify that the following attached

Transmittal of Appellant's Brief

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Mail Stop Appeal Brief-Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

*Thompson E. Fehr*  
Thompson E. Fehr

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**TRANSMITTAL OF APPELLANT'S BRIEF (PATENT APPLICATION-37 CFR 41.37)**

1. Transmitted herewith is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on September 5, 2006.

**2. STATUS OF APPLICANT**

This application is on behalf of a small entity.

The statement of small entity status has already been filed.

**3. FEE FOR FILING APPEAL BRIEF**

Pursuant to 37 CFR 41.20(b)(2) the fee for filing the Appeal Brief is \$250.00.

Appeal Brief fee due \$250.00.

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TRANSMITTAL OF APPELLANT'S BRIEF  
(PATENT APPLICATION-37 CFR 41.37)



4. EXTENSION OF TERM

The proceedings herein are for a patent application, and the provisions of 37 CFR 1.136 apply.

Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)(1)-(5)) for a total of four months. The requisite fee for a small entity is \$795.00.

Fee \$795.00

5. TOTAL FEE DUE

The total fee due is

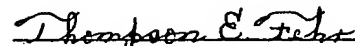
Appeal brief fee \$250.00

Extension fee \$795.00

TOTAL FEE DUE \$1,045.00

6. Attached is a check in the sum of \$1,045.00.

DATED this 5<sup>th</sup> day of March, 2007.



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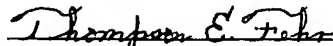
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**APPELLANT'S BRIEF (37 CFR 41.37)**

This brief is in furtherance of the Notice of Appeal filed in this case on September 5, 2006.

The fees required under § 41.20 and any required petition for extension of time for filing this brief and fees therefor are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

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This brief contains the following items, under headings of the same name and in the order given:

REAL PARTY IN INTEREST

RELATED APPEALS AND INTERFERENCES

STATUS OF CLAIMS

STATUS OF AMENDMENTS

SUMMARY OF CLAIMED SUBJECT MATTER

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

ARGUMENT

Claims 5 and 6 under 35 U.S.C. § 102

Claims 7 and 8 under 35 U.S.C. § 103 over Morgan et al. in View of Hopey

Claims 5 through 8 under 35 U.S.C. § 103 over Gustafsson in View of Morgan et al.

CLAIMS APPENDIX

EVIDENCE APPENDIX

RELATED PROCEEDINGS APPENDIX

The final page of this brief bears the attorney's signature.



### REAL PARTY IN INTEREST

The real party in interest is the owner and inventor Ralph S. Norman.

### RELATED APPEALS AND INTERFERENCES

There are no other prior or pending appeals, interferences, or judicial proceedings known to Appellants, Appellants' legal representative, or any assignee which may be related to, directly affect, or be directly affected by or have a bearing on the Board's decision in the pending appeal.

### STATUS OF CLAIMS

Claim 1 through 4 have been canceled.

Claims 5 through 8 have been rejected.

Claims 5 through 8 are being appealed.

### STATUS OF AMENDMENTS

No amendment has filed subsequent to final rejection.

### SUMMARY OF CLAIMED SUBJECT MATTER

The disclosure of the Application is so brief that the claimed subject matter can be understood by primarily quoting from the application.

Paragraphs [0001] and [0002] state:

**[0001]** This invention relates to a device that uses a fluid to dampen a force that tends to move the plane of rotation of a steerable wheel or wheels of a vehicle having a shaft used to steer such wheel or wheels away from being generally parallel to the frame of such vehicle. It also relates to any steering device, such as a ski of a snowmobile or the exhaust jet of a personal watercraft, that uses a shaft or the like in the steering process.

...



[0002] Dampening devices of the type subject to the present invention are those which contain a rotatable wiper in a housing having a channel running from the a portion of the housing on a first side of the wiper to a portion of the housing on a second side of the wiper so that when the housing is filled with fluid, as the wiper is moved, it forces fluid through the channel.

The degree of dampening is adjusted with a valve that varies the effective cross-sectional area of the channel, with the dampening being greater when the effective cross-sectional area is smaller. If desired a more detailed explanation can be found in United States patent no. 6,401,884; United States patent no. 4,773,514; or United States patent application serial no. 10/166,498 (publication no. 20030136621).

Paragraphs [0005] through [0007] of the present Application continue:

[0005] The present Improved Fluidic Dampening Device has a first clamp near a first side of a housing containing a wiper and a channel for transferring fluid from a first side of the wiper to a second side of the wiper as well as a second clamp near a second side of the housing.

[0006] Each clamp has an upper section which is releasably fastenable to the handlebars of a vehicle. Thus, the housing is suspended below the handlebars, decreasing the likelihood of the face of a rider striking the housing when the vehicle is jarred.

[0007] Preferably, the clamps can also be attached to the top of a triple clamp, which is a device with two deformable apertures that can be squeezed together with a bolt to hold the triple clamp to each of the forks going down on opposite sides of the wheel of a mortorcycles and with a third aperture to accommodate the post about which the forks rotate in order to turn the front wheel of the motorcycles.

And paragraphs [0016] and [0018] through [0020.1] complete the explanation:

[0016] The present Improved Fluidic Dampening Device has, as seen in FIG. 1 and FIG. 2, a first clamp 100 attached near the left side 101 of a housing 1 containing a bypass channel 9 having a first port 10 in a first side wall 3 and a second port 11 in the second side wall 4. A wiper 7 is rotatably mounted between the side wall[s] 3, 4.

...



[0018] A second clamp **102** is, as seen in FIG. 1 and FIG. 2, attached near the right side **103** of the housing **1**.

[0019] An upper segment **104** of the first clamp **100**, seen in FIG. 3, is releasably attached to a lower segment **105** of the first clamp **100**, although [, as seen in FIG. 8,] a first end **106** of the upper segment **104** can be rotatably attached to the lower segment **105** while a second end **107** of the upper segment **104** is releasably attached to the lower segment **105**, so as to create an aperture **108** to accommodate handlebars. Releasable attachment is preferably accomplished with one or more screws **109**.

[0020] Similarly, an upper segment **110** of the second clamp **102**, seen in FIG. 4, is releasably attached to a lower segment **111** of the second clamp **102**, although [, as illustrated in FIG. 9,] a first end . . . [113] of the upper segment **110** can be rotatably attached to the lower segment **111** while a second end . . . [112] of the upper segment **110** is releasably attached to the lower segment **111**, so as to create an aperture **114** to accommodate handlebars.

[0020.1] The housing **1** is preferably so attached to the first clamp **100** and to the second clamp **102** that the uppermost portion **117** of the housing **1** is lower [than] the lowermost portion **118** of the aperture **108** and the lowermost portion **119** of the aperture **114**.

The structure of independent claim 5 is found in paragraphs [0016] and [0018] through [0020.1], which have been quoted above but excluding the rotational attachment option of paragraphs [0019] and [0020], excluding the preferred method of releasable attachment of paragraph [0019] except as such structure could be added to the explicit claim elements in accordance with MPEP § 211.03 since the phrase “comprising” was utilized, and including the preference of paragraph [0020.1].

The structure of independent claim 7 differs from that of independent claim 5 only in that the optional rotational attachments of paragraphs [0019] and [0020] is employed.

#### GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner has rejected claims 5 and 6 under 35 U.S.C. § 102(b) as being anticipated by Morgan et al. (United States patent no. 6,802,519).



Claims 7 and 8 have been rejected by the Examiner under 35 U.S.C. § 103(a) as being unpatentable over Morgan in view of Hopey (United States patent no. 6,145,637).

And claims 5 through 8 have been rejected by the Examiner under 35 U.S.C. §103(a) as being unpatentable over Gustafsson (United States patent no. 4,773,514).

## ARGUMENT

### Claims 5 and 6 under 35 U.S.C. § 102

Claim 5 of the present Application provides:

5. An improved fluidic dampening device of the type having a housing with an uppermost portion and containing a wiper and a channel for transferring fluid from a first side of the wiper to a second side of the wiper, wherein the improvement comprises:

a first clamp having an upper segment and a lower segment with the upper segment releasably connected to the lower segment so as to create an aperture with a lowermost portion, said first clamp being attached to the housing near a left side of the housing; and

a second clamp having an upper segment and a lower segment with the upper segment releasably connected to the lower segment so as to create an aperture with a lowermost portion, said second clamp being attached to the housing near a right side of the housing, wherein the attachment of said first clamp to the housing and the attachment of said second clamp to the housing is such that the uppermost portion of the housing is lower than the lowermost portion of the aperture in the first clamp and also lower than the lowermost portion of the aperture in the second clamp.

And claim 6 states:

6. The improved fluidic dampening device as recited in claim 5, further comprising:

a triple clamp having a top, with the top of the triple clamp being attached to the lower segment of said first clamp and to the lower segment of said second clamp.



The housing could be connected directly to the first clamp or connected to the first clamp through some additional structure. This is similarly true for the housing and the second clamp. Under the doctrine of claim differentiation, though, such additional structure could not be the triple clamp because the triple clamp is added in claim 6 whereas there was already a connection between the housing and the first clamp as well as the housing and the second clamp in claim 5.

Hence, Morgan (United States patent no. 6,802,519) cannot, Appellant respectfully submits, anticipate claim 5.

And since, claim 6 depends upon claim 5, Morgan similarly cannot, Appellant respectfully suggests, anticipate claim 6.

Claims 7 and 8 under 35 U.S.C. § 103 over Morgan et al. in View of Hopey

Appellant herein incorporates by reference the preceding argument with respect to claims 5 and 6.

As explained therein, Morgan et al. does not contain the requisite connection between the housing and either the first clamp or the second clamp since such connection cannot occur through the triple clamp. Therefore, Morgan et al. cannot be modified by altering the clamps and result in the structure of claim 7 or claim 8 (which depends upon claim 7).

Although Appellant must respectfully assert that he cannot find a two-part clamp having one end of each part rotatably connected to each other in Hopey (United States patent no. 6,145,637), Appellant relies principally upon the preceding paragraph respectfully to suggest that claims 7 and 8 are not obvious over Morgan et al. in View of Hopey.

Claims 5 through 8 under 35 U.S.C. § 103 over Gustafsson in View of Morgan et al.

Finally, the Examiner has said:



Gustafsson does not disclose mounting the clamps on top of the housing. Morgan teaches mounting the clamps on top of the housing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to mount the clamps on top of the housing as taught by Morgan et al in the device of Gustafsson as such is merely a design choice. This arrangement allows for a horizontally short (and vertically longer) assembly which may be useful depending on the designed space in which the device is suppose to fit.

Morgan et al. (United States patent no. 6,802,519) avoided having a dampener be above the handlebars of a motorcycle by eliminating the traditional damper with a housing separate from the triple clamp and placing most of the internal workings of the dampener within the triple clamp.

Appellant, however, recognized and solved a different problem, viz., determining how a traditional dampener with a housing separate from the triple clamp could be located below the handlebars.

Recognition of such a problem alone establishes patentability, as will be explained further below. But, Appellant respectfully believes, Appellant's solution is patentable even independent of the recognition of a new problem.

Considering first, however, recognition of the problem, significantly, several Board judicial cases have addressed this issue.

The Board of Appeals held in *Ex parte Phair*, 1. U.S.P.Q. 133, 134 (Bd. App. 1929), that "... invention may exist in the discovery of the cause of a defect in an existing machine or process and applying a remedy therefor even though, after the cause is understood, the remedy would be obvious." See, also, *Ex parte Campbell*, 211 U.S.P.Q. 575 (Bd. App. 1980).

It is easy to see the simplicity of construction and method of operation of a satisfactory operable device after it has been constructed and explained, and the courts have frequently commented upon the fact that some of the apparently simplest modifications and changes promoted such revolutionary results as to have a marked influence upon the development of the art and that in such



instances, in determining the presence or absence of invention, hindsight should not be substituted for foresight. . . . the conception of doing a thing, the result of which is new and useful, must be considered along with the actual steps of doing it in considering the presence or absence of patentability . . . .

*In re De Lancey*, 34 C.C.P.A. 849, 72 U.S.P.Q. 477, 159 F.2d 737, 741 (1947).

The discovery of a problem calling for an improvement is often a very essential element in an invention correcting such a problem; and though the problem, once realized, may be solved by use of old and known elements, this does not necessarily negative invention.

*In re Bisley*, 39 C.C.P.A. 982, 94 U.S.P.Q. 80, 197 F.2d 355, 363 (1952). *See, also, In re Hamilton*, 20 C.C.P.A. 987, 17 U.S.P.Q. 245, 64 F.2d 141 (1933).

In many inventions there are two distinct steps: first, the conception of the general result wished for; second, the discovery of a way of obtaining it. In a large majority of cases, perhaps, the first may be obvious to every one interested in a particular art, and it is the second which calls for the exercise of inventive genius. But that is not always so. It may well be that two or more machines, appliances, or tools are old and well known. Some day it dawns on some one that, if they are combined, new and useful results will be obtained. It may be that, so soon as the advantages of the combination are understood, the means of bringing it about are within the capacity of any fairly skilled mechanic. In a third class of cases inventive genius may be required both in perceiving the combination that is desirable, and in finding out a practical way of making it.

*In re Earle*, 26 C.C.P.A. 974, 41 U.S.P.Q. 24, 102 F.2d 232, 235 (1939), quoting *Rosemary Manufacturing Co. v. Halifax Cotton Mills, Inc.*, 257 F. 321, 322 (4<sup>th</sup> Cir. 1919).

Finally, the court's opinion for *In re Pennington*, 44 C.C.P.A. 789, 113, U.S.P.Q. 81, 241 F.2d 750, 754 (1957), remarked that when an essential portion of the inventor's contribution to the art resided in appreciating a deficiency in the prior art, the fact that once the problem had been appreciated, one skilled in the art might be able to construct the inventor's apparatus without the further use of the inventive faculty . . . does not detract from the inventive nature of the initial concept."



Now, second, with respect to the patentability of Appellant's structure, Appellant respectfully submits that he recognized that a traditional dampener involving a housing separate from the triple clamp could be placed below the handlebars if (a) the clamps were raised such that the lowermost portion of the aperture (used to accommodate the handlebars) in each clamp were above the uppermost portion of the housing and (b) one clamp was connected to the housing near the left side of the housing while the other clamp was connected to the housing near the right side of the housing. The clamps are not shown in any Figure of the present application to be attached to the top of the housing; and Appellant, respectfully submits, one of ordinary skill in the art would not so locate the clamps because a traditional housing is not intended to withstand the forces exerted upon the clamps when the handlebars are turned and, independently and even more convincingly, one of ordinary skill in the art attaches the bottom of the clamps to the triple clamp.

Moreover, Morgan et al. merely attached the clamps in the traditional fashion to the top of the triple clamp. This would not, Appellant respectfully submits, cause one of ordinary skill in the art to attach the clamps to the top of the housing for a traditional dampener. There is simply no motivation or suggestion for attaching the clamps to the top of the housing for a traditional dampener.

Consequently, Appellant respectfully suggests that claims 5 through 8 are not unpatentable under 35 U.S.C. § 103 over Gustafsson in view of Morgan et al.



## CLAIMS APPENDIX

5. An improved fluidic dampening device of the type having a housing with an uppermost portion and containing a wiper and a channel for transferring fluid from a first side of the wiper to a second side of the wiper, wherein the improvement comprises:

a first clamp having an upper segment and a lower segment with the upper segment releasably connected to the lower segment so as to create an aperture with a lowermost portion, said first clamp being attached to the housing near a left side of the housing; and

a second clamp having an upper segment and a lower segment with the upper segment releasably connected to the lower segment so as to create an aperture with a lowermost portion, said second clamp being attached to the housing near a right side of the housing, wherein the attachment of said first clamp to the housing and the attachment of said second clamp to the housing is such that the uppermost portion of the housing is lower than the lowermost portion of the aperture in the first clamp and also lower than the lowermost portion of the aperture in the second clamp.

6. The improved fluidic dampening device as recited in claim 5, further comprising:

a triple clamp having a top, with the top of the triple clamp being attached to the lower segment of said first clamp and to the lower segment of said second clamp.

7. An improved fluidic dampening device of the type having a housing with an uppermost portion and containing a wiper and a channel for transferring fluid from a first side of the wiper to a second side of the wiper, wherein the improvement comprises:

a first clamp having an upper segment and a lower segment with a first end of the upper segment rotatably connected to the lower segment and with a second end of the



upper segment releasably connected to the lower segment so as to create an aperture with a lowermost portion, said first clamp being attached to the housing near a left side of the housing; and

a second clamp having an upper segment and a lower segment with a first end of the upper segment rotatably connected to the lower segment and with a second end of the upper segment releasably connected to the lower segment so as to create an aperture, said second clamp being attached to the housing near a right side of the housing, wherein the attachment of said first clamp to the housing and the attachment of said second clamp to the housing is such that the uppermost portion of the housing is lower than the lowermost portion of the aperture in the first clamp and also lower than the lowermost portion of the aperture in the second clamp.

8. The improved fluidic dampening device as recited in claim 7, further comprising:

a triple clamp having a top, with the top of the triple clamp being attached to the lower segment of said first clamp and to the lower segment of said second clamp.



## EVIDENCE APPENDIX

There is no evidence for this appendix.

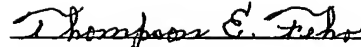


## RELATED PROCEEDINGS APPENDIX

There are no documents for this appendix since, as explained above, there are no related proceedings.



DATED this 5<sup>th</sup> day of March, 2007.



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